



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Adress: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,651	03/31/2005	Maik Kindermann	2005-0427A	2263
513	7590	07/18/2008		
WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			EXAMINER	
			BERCH, MARK L	
			ART UNIT	PAPER NUMBER
			1624	
			MAIL DATE	DELIVERY MODE
			07/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/529,651	Applicant(s) KINDERMANN ET AL.
	Examiner /Mark L. Berch/	Art Unit 1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 April 2008.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2,4,5,8-25 and 27-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 29 and 30 is/are allowed.
- 6) Claim(s) 2,4,5,8-25,27,28 and 31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4, 5, 8-25, 27-28, 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The definition of label in claim 2 remains unclear. Note that L is a moiety, "a contrast reagent" is a molecule. Nearly all the terms are unclear. A "spectroscopic probe" could be anything. Even a methyl group can be detected spectroscopically (e.g. PMR). Does applicant intend the methyl group? Similarly, a "moiety which is one part of a specific binding pair which is capable of specifically binding to a partner" is completely vague. A "partner" could be anything at all --- a gene, enzyme, receptor, bone, molecule (sugar, hemoglobin, etc) , even water itself. There is no way of knowing what "specifically binding" would require, beyond actual binding.
2. The claim 17 term "dendritic structures" is indefinite. There is no clear guideline as to what degree of branching is needed to qualify as a dendrite. The traverse is unconvincing. Applicants point to page 12, line 21 which calls it "tree-like". This is not definite either. The range of "like" is unknown. Until such time as applicants can demonstrate what degree of branching is needed to qualify as a dendrite, it cannot be considered definite.

3. The new language in claim 28 is not always clear. The phrase “carry separately deprotectable protection groups, one protection group is separately deprotected and a label attached to it” --- is the latter part an explanation of what “carry separately deprotectable protection groups” means, or is it a steps which is required by claim 28? The same goes for other phrases. Note that this is introduced by “carry” which is a verb, but is presumably not intended as an actual step.
4. In the phase “deprotectable protection groups”, what role does that first term actually play? By its very nature, a protecting group must be removable. If it cannot be removed, it is not a protecting group. Also, does “deprotectable” mean “removable”?
5. It is also unclear what “the linker R4 further extended” means? What role does “further” play – i.e. how would the claim be different if that word were not present? What does it mean to extend R4? What actual step is it? Does it mean to extend the number of electrophilic/nucleophilic groups present? It is also unclear whether the R4 in claim 28 is the R4 for the starting material or the R4 for the final product.
6. In addition, the “repeated depending on the number of protected reactive nucleophilic and electrophilic groups” limitation is unclear. This might, or might not, mean that every protected group be deprotected be replaced with a label.
7. It is also unclear whether claim 28 requires that all of the reactive groups be protected, or just one or more.
8. In claim 28, Deprotection of what? It is understood that this is Deprotection of a protecting group, but a protecting group of what?
9. Claim 31 is very unclear. It is unknown what “manipulating” is supposed to cover. The traverse is unpersuasive. Applicants point to description of the fusion protein, but that

does not tell us what "manipulating a protein of interest means". Applicants further points "in particular page 14, lines 1-26, for "manipulating" as binding to a solid support and further steps made possible by binding to a solid support". But there is no indication there that "manipulating" means binding to a solid support. It simply says that the fusion protein can be bound to a solid support. Further, it is hard to see how it will fit. All that claim 31 actually requires, for the manipulating branch of the claim, is contacting the fusion protein "with an AGT substrate carrying a label". That doesn't seem to have anything to do with binding to a solid support. Moreover, even if true what else would "manipulating" cover other than this? Applicants also point to the next paragraph, but that deals with studying the role of the proteins, and detecting the proteins, which does not tell us the scope of manipulating the proteins. That is manipulating the proteins doesn't necessarily entail studying them.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Mark L. Berch/ whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Berch/
Primary Examiner
Art Unit 1624

7/17/2008